



\$ 12



Docket No.: 249856US2S DIV

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

JAMES J. KULBASKI
(703) 413-3000
JKULBASKI@OBLON.COM

SCOTT A. McKEOWN
SENIOR ASSOCIATE
(703) 413-3000
SMCKEOWN@OBLON.COM

RE: Application Serial No.: 10/800,661
Applicants: Shinichi KIKUCHI, et al.
Filing Date: March 16, 2004
For: DIGITAL VIDEO SYSTEM
Group Art Unit: 2615
Examiner:

SIR:

Attached hereto for filing are the following papers:

SUBMISSION OF TERMINAL DISCLAIMER & TERMINAL DISCLAIMER

Our credit card payment form in the amount of **\$130.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

James J. Kulbaski
Registration No. 34,648

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

Scott A. McKeown
Registration No. 42,866

Docket No. 249856US2S DIV



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Shinichi KIKUCHI, et al.

SERIAL NO: 10/800,661

GAU: 2615

FILED: March 16, 2004

EXAMINER:

FOR: DIGITAL VIDEO SYSTEM

TERMINAL DISCLAIMER

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

|| 08/18/2005 CNGUYEN2 00000042 10800661

01 FC:1814

130.00 0P

SIR:

Now comes the undersigned, Attorney of Record in the present application, who avers as follows:

Kabushiki Kaisha Toshiba is the owner of the entire right, title and interest in and to the invention claimed and disclosed in the above-captioned patent application by virtue of assignment, said Assignment having been recorded in the U.S. Patent and Trademark Office at reel no. 013934, frame(s) 0056.

Kabushiki Kaisha Toshiba hereby disclaims the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173 as presently shortened by any terminal disclaimer of any patent issuing from application Serial Nos. 10/417,214; 10/800,644; 10/800,654; 10/800,655; 10/800,686; 10/800,689; 10/800,690; 10/800,760; 10/800,761; 10/800,762; 10/800,851; 10/800,852; 10/800,853; 10/800,855; 10/800,856; 11/004,899; 11/004,900; 11/004,931; 11/005,002; 11/005,017; 11/005,022; 11/005,024; 11/005,026; 11/005,047; 11/005,048; 11/005,050; and 11/005,051, and for Patent No. 6,580,872, and hereby agrees that any patent so granted on said above-captioned application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to any patent issuing from application Serial Nos. 10/417,214; 10/800,644; 10/800,654; 10/800,655; 10/800,686; 10/800,689; 10/800,690; 10/800,760; 10/800,761; 10/800,762; 10/800,851; 10/800,852; 10/800,853; 10/800,855; 10/800,856; 11/004,899; 11/004,900; 11/004,931; 11/005,002; 11/005,017; 11/005,022; 11/005,024; 11/005,026; 11/005,047; 11/005,048; 11/005,050; and 11/005,051, and for Patent No. 6,580,872, this agreement to run with any patent granted on the above-captioned application and to be binding upon the grantee, its successors or assigns.

Kabushiki Kaisha Toshiba does not disclaim any terminal part of any patent granted on the above-captioned application that would extend to the full statutory term as defined in 35 U.S.C. 154 and 173 as presently shortened by any terminal disclaimer of any patent issuing from application Serial Nos. 10/417,214; 10/800,644; 10/800,654; 10/800,655; 10/800,686; 10/800,689; 10/800,690; 10/800,760; 10/800,761; 10/800,762; 10/800,851; 10/800,852; 10/800,853; 10/800,855; 10/800,856; 11/004,899; 11/004,900; 11/004,931; 11/005,002; 11/005,017; 11/005,022; 11/005,024; 11/005,026; 11/005,047; 11/005,048; 11/005,050; and 11/005,051, and for Patent No. 6,580,872, in the event that any said issued patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is

statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

8/17/05

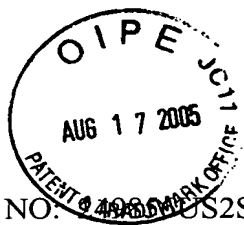
Date Signed

James J. Kulbaski
Registration No. 34,648

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)



DOCKET NO. 10/800,661 US2S DIV

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
SHINICHI KIKUCHI, ET AL. : EXAMINER:
SERIAL NO: 10/800,661 :
FILED: MARCH 16, 2004 : GROUP ART UNIT: 2615
FOR: DIGITAL VIDEO SYSTEM :

SUBMISSION OF TERMINAL DISCLAIMER

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

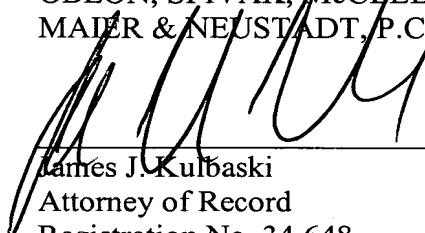
In response to the telephone conversation held with Examiner Onuaku, applicants submit the enclosed Terminal Disclaimer.

It is respectfully noted that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, in the present case, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission that a double patenting rejection would be appropriate in light of any of the references listed in the enclosed terminal disclaimer.

The pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Scott A. McKeown
Registration No. 42,866

I:\ATTY\ET\249856US\249856US SUB OF TD.DOC